

REMARKS

The Office Action

In the Office Action, the Examiner rejects:

1. Claims 22-44 under 35 U.S.C. §112, first paragraph, as containing subject matter that allegedly was not described in the specification as originally filed, namely, the term “reflecting surface”;
2. Claims 22-44 under 35 U.S.C. §112, second paragraph, as being allegedly indefinite with respect to the term “layer of metal”;
3. Claims 22-27, 29-35 and 37-44 under 35 U.S.C. §102(b) as being anticipated by the following citations:

Claims	Citation
22-27, 29-35 & 37-44	JP 10077438
22-26, 29-30, 33, 35, 37-38, 40, 42 & 44	JP 7118592
22-27, 29-30, 32, 38 & 42	EP 600205

4. Claims 28, 36 and 37 under 35 U.S.C. §103(a) as being unpatentable (obvious) over the following citations:

Claims	Citation
28	JP 10077438, JP 7118592 or EP 600205 in view of US 5510397 (Okuda et al.)
36	JP 10077438 or JP 7118592 in view of US 308728 (Linton)
37	JP 10077438, JP 7118592 or EP 600205 in view of US 5277711 (Schmidt et al.)

The Pending Claims

Each of pending independent claims 22, 23, 29, 33, 38, 40, 42 and 44, as amended, and new independent claims 45, 48, 51, 52, 54, and 56 recite, in pertinent part:

“an inorganic pigment which is coated with metal which provides a metal reflective surface...”

- Claims 22, 23, 29, 33, 38, 40, 42 and 44

or

“an inorganic pigment coated not with a metal oxide but with a metal...”

- Claims 45, 48, 51, 52, 54, and 56.

The Section 112 Rejections

The Examiner has rejected claims 22-44 as containing subject matter not described in the specification.

The specification, as originally filed, discloses, *inter alia*, the following:

“The metal coated inorganic pigment to be used in the present invention comprises, for example, an inorganic pigment which is coated with metal or metal oxide...”

- page 4, line 25, through page 5, line 2.

The Examiner has admitted:

“...the present specification does disclose that the inorganic pigment is coated with metal and discloses that the inorganic pigments include aluminum which would necessarily provide a reflecting surface...”

- Office Action of January 15, 2003, page 3, first paragraph.

The recited claim recitation now reads:

“... an inorganic pigment which is coated with metal which provides a... reflecting surface...”

or

“...an inorganic pigment coated not with a metal oxide
but with a metal...”

These recitations are consistent with the specification and the Examiner’s admission.

The Examiner asserts that

“there is no support for any type of reflecting surface.
That is, reflecting surfaces can include those made
from materials other than metals or metal oxides...”
(Emphasis in original.)

Applicants have restricted the type of reflecting surface to a metal surface. Consequently, any
basis for rejection on this ground has been removed.

The Examiner has also rejected claims 22-44 on the basis of indefiniteness with regard to the
term “layer of metal”. Applicants have amended the claims to delete that term. Also, the claims
have been restricted to

“... an inorganic pigment which is coated with metal...”

for the sake of clarity.

The Anticipation Rejection.

The anticipation rejections are predicated on JP10077438, JP7118592 and EP600205 which
are alleged to disclose

“mica coated with titanium oxide or iron oxide.”

(See Office Action dated April 22, 2002 at paragraphs 6, 7 and 8, respectively.) These are
disclosures of mica coated with a metal oxide. However, the claims now recite “an inorganic
pigment which is coated with metal...” or “...an inorganic pigment coated not with a metal oxide
but with a metal...”. In order for prior art to anticipate rejection under 35 U.S.C. § 102, it must

meet every element of the claimed invention. *Hybritech Inc. Monoclonal Antibodies, Inc.*, 802 F. 2d 1367, 231 U.S.P.Q., 81, 90 (Fed. Cir. 1986). More specifically, an anticipation rejection requires a showing that each limitation of a claim must be found in a single reference, practice or device. *In re Donahue*, 766 F. 2d 531, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

As a consequence, JP10077438, JP7118592 and EP600205 fail to anticipate the present claims which recite, in pertinent part,

“inorganic pigment which is coated with metal”

or

“inorganic pigment coated not with a metal oxide
but with a metal”

The Obviousness Rejection.

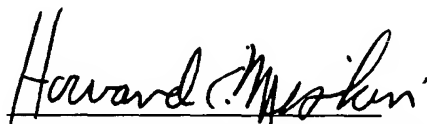
The primary references for the rejection of all claims rejected on the basis of obviousness are the aforesaid JP10077438, JP7118592 or EP600205. It is submitted that the cited secondary references do not remedy the aforesaid deficiencies in the disclosure of the primary references.

CONCLUSION

In view of the foregoing amendments to the claims and remarks, reconsideration and allowance of the application is respectfully requested.

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Respectfully submitted,



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VERSION WITH MARKINGS TO SHOW CHANGES MADE

22. (Twice Amended.) An aqueous glittering ink composition comprising
- a metal coated inorganic pigment,
 - a water-soluble resin,
 - a water-soluble organic solvent, and
 - water,
- wherein said metal coated inorganic pigment is an inorganic pigment which is coated with [a] metal [and/or metal oxide and has] which provides a metal reflecting surface [or layer of metal].
23. (Twice Amended.) An aqueous glittering ink composition comprising
- a metal coated inorganic pigment,
 - a water-soluble resin,
 - a water-soluble organic solvent,
 - water, and
 - a colorant,
- wherein said metal coated inorganic pigment is an inorganic pigment which is coated with [a] metal [and/or metal oxide and has] which provides a metal reflecting surface [or layer of metal].
29. (Twice Amended.) A writing tool having an ink container in which an aqueous glittering ink composition is packed, wherein said aqueous glittering ink composition comprises

an inorganic pigment which is coated with [a] metal [and/or metal oxide and has]
which provides a metal reflective surface [or layer of metal] and having a median
diameter of about 5 - 100 μm ,
a water-soluble resin,
a water soluble organic solvent, and
water.

33. (Twice Amended.) A writing tool having an ink container that is made of a hollow tube equipped with a ball-point pen tip at one end, wherein said ink container has an aqueous glittering ink composition packed therein, said aqueous glittering ink composition comprising

an inorganic pigment which is coated with [a] metal [and/or metal oxide and has]
which provides a metal reflecting surface [or layer of metal] and having a median
diameter of about 5 - 100 μm and contained in about 1.0 - 40% by weight,
a water-soluble resin contained in about 0.01 - 40% by weight and
a water-soluble organic solvent contained in about 1.00 - 40% by weight relative to
the total amount of the ink composition, and
water.

38. (Twice Amended.) A method for using an aqueous glittering ink composition for a writing tool, the method comprising:

providing an aqueous glittering ink composition which comprises an inorganic
pigment which is coated with [a] metal which provides a metal reflecting surface and
having a median diameter of about 5 - 100 μm ,
a water-soluble resin,

a water-soluble organic solvent, and
water.

40. (Twice Amended.) A method for using an aqueous glittering ink composition for a writing tool, the method comprising:

providing an aqueous glittering ink composition which comprises
an inorganic pigment which is coated with [a] metal [and/or metal oxide and has]
which provides a metal reflecting surface [or layer of metal] and has a median
diameter of about 5 - 100 μm ,
a water-soluble resin,
a water-soluble organic solvent, and
water,

packing said aqueous glittering ink composition into an ink container made of a hollow tube,
and

equipping a ball-point pen tip with said ink container.

42. (Twice Amended.) A method for using an aqueous glittering ink composition for a writing tool, the method comprising:

providing an aqueous glittering ink composition which comprises
an inorganic pigment which is coated with [a] metal [and/or metal oxide and has]
which provides a metal reflecting surface [or layer of metal] and having a median
diameter of about 5 - 100 μm and contained in about 1.0 - 40% by weight,
a water-soluble resin contained in about 0.01 - 40% by weight, and
a water-soluble organic solvent contained in about 1.00 - 40% by weight relative to
the total amount of the ink composition.

44. (Twice Amended.) A method for using an aqueous glittering ink composition for a writing tool, the method comprising:

providing an aqueous glittering ink composition which comprises
an inorganic pigment which is coated with [a] metal [and/or metal oxide and has]
which provides a metal reflecting surface [or layer of metal] and having a median
diameter of about 5 - 100 μm and contained in about 1.0 - 40% by weight,
a water-soluble resin contained in about 0.01 - 40% by weight, and
a water-soluble organic solvent contained in about 1.0 - 40% by weight relative to
the total amount of the ink composition;

packing said aqueous glittering ink composition into an ink container made of a hollow tube,
and equipping a ball point pen tip with said ink container.